

REMARKS

In the Office Action dated September 30, 2004, claims 1-26 were rejected under 35 U.S. C. §101 because the Examiner stated the claimed invention is directed to non-statutory subject matter. The Examiner stated that the basis of the rejection is a two-prong test consisting of a determination of (1) whether the invention is within the technological arts, and (2) whether the invention produces a useful, concrete and tangible result.

The Examiner acknowledged that the second criterion is satisfied by claims 1-26, but stated the method set forth in claims 1-26 could be performed in the mind of a user, or by the use of a pencil and paper. In response, at appropriate locations in claims 1-26, the term "electronically" has been inserted to preclude those claims from being interpreted as being performed in the mind of a user or with a pencil and paper. The rejection of claims 1-26 under 35 U.S.C. §101 is submitted to be overcome by these amendments.

Claims 1-5, 7, 9, 10, 13-18, 21-33 and 35 were rejected under 35 U.S.C. §103(a) as being unpatentable over LoBiondo et al in view of Barnes et al. This rejection is respectfully traversed for the following reasons. In the earlier Office Action dated June 11, 2002, these claims were rejected under 35 U.S.C. §102(e) based on the LoBiondo et al reference by itself. Applicant acknowledged that the LoBiondo et al reference discloses a system for automatically generating an order to re-supply a consumed item, with the order being generated and placed before the item is completely consumed. Applicant further stated, however, that the LoBiondo et al reference does not contemplate the possibility of an order not being filled. There is no teaching in the LoBiondo et al reference to conduct any type of check at the order-filling facility of the incoming order as to its authenticity, nor any other

characteristic thereof. Orders are filled at the order-filling facility in the LoBiondo reference with no questions being asked. There is no teaching in the LoBiondo et al reference that an order might not be filled, and therefore there is no teaching in the LoBiondo et al reference as to any conditions that might preclude the filling of an order.

In the latest Office Action dated September 30, 2004, the Examiner is now additionally relying on the Barnes et al reference as providing teachings regarding an order-filling system wherein the items that can be supplied to a requesting entity (customer) are limited to items in a catalog list that is made available to the ordering entity. Dependent on the access level associated with a particular ordering entity, only a limited number of items from the entire catalog list are made available to the particular ordering entity. In substantiating these teachings of the Barnes et al reference, the Examiner cited statements from the Barnes et al reference from the introductory portion thereof. In view of their introductory nature, these statements are extremely general, and the actual details of the method and system disclosed in the Barnes et al are provided at subsequent passages in the Barnes et al reference. The basic steps for placing and filling an order in the context of the Barnes method and system are described at column 6, lines 33-65 of the Barnes et al reference. As can be seen from this more detailed explanation of how the Barnes et al method and system operate, the Barnes et al method and system differ in several significant respects from the subject matter disclosed and claimed in the present application.

First and foremost, as in the LoBiondo et al reference, there is no possibility discussed in the Barnes et al reference of a requested order not being filled. This is because in the Barnes et al method and system, before a customer places an order, the customer is given the aforementioned catalog list, the contents of which may be

restricted depending on the access level of the customer. The customer places an order only after already being provided with this (possibly limited) catalog list, but once the customer is presented with the customer list that is suitable for that customer, the customer is free to order any item on that catalog list. Therefore, a customer's order, since it can only be selected from the list that is presented to the particular customer, can never include an item that is not on the presented list, and therefore there is no possibility for the customer to place an order that cannot be filled from the list. Thus, the Barnes et al method and system prevent the customer from ever generating an order that cannot be filled, because the customer is permitted to create the order only by selecting from a catalog list that is specifically designed so as *not* to include any items for which the particular customer in question is not authorized (by virtue of the customer's access level).

Moreover, the Barnes et al system defeats the possibility of being conducted completely automatically or completely electronically, because a manual selection by the customer must be made after the customer is presented with a list that is determined dependent on the customer's access level. Thus, it is necessary for a series of back-and-forth communications to take place between the customer and the order-filling facility. The customer must first identify himself or herself so that the customer's access level can be ascertained. Dependent on that access level, the customer is then presented, in a further communication, with an appropriate customer list. The customer must then make a selection from that list and communicate that selection, in a further communication, to the order-filling facility.

Independent claim 1 has been amended to make clear that such back-and-forth communication is precluded in the method of claim 1, by stating that the ordering message is communicated from the device to the data center only

thereafter establishing a communication between the device and the data center. In the Barnes et al reference, it is not possible for an ordering message to be generated until *after* at least two communications have occurred between the customer and the order-filling facility.

Claim 1 also has been amended to make clear that the order is filled only if the requested supply item conforms to at least one permissible supply item, and otherwise the order is not filled. As noted above, neither the LoBiondo et al reference nor the Barnes et al reference contemplates the possibility of an order not being filled.

Therefore, even if the LoBiondo et al system were modified in accordance with the teachings of Barnes et al, a method as set forth in claim 1 still would not result. Moreover, since neither of those references contemplates the possibility of an order not being filled, a person of ordinary skill in the field of designing order-filling systems would have no reason to even consult those references for the purpose of designing a method or a system wherein it is expressly intended that, under appropriate conditions, an ordering message for a supply item might not be filled.

Independent claim 27 also has been amended to clarify the operation of the control unit in the event that an ordering message is determined, at a remote data center, not to be authentic. Claim 27 requires that the control unit modify the operation of the device that transmitted the ordering message, if a message of the aforementioned type is received from the remote data center. As noted above, since the LoBiondo et al nor the Barnes et al reference contemplates the possibility of an ordering message not being authentic, there is no teaching in either of those references to modify a device from which the ordering message originated in the event that the ordering message is not authentic. As discussed above, the LoBiondo

et al reference is simply not concerned in any way with checking whether an incoming order is authentic or not. All incoming orders in the LoBiondo et al system, with no questions being asked. As also discussed above, the Barnes et al reference is specifically designed to prevent a non-authentic ordering message from ever being received, and therefore the Barnes et al reference does not provide any teachings as to how the method or the system disclosed in that reference would respond to a non-authentic message. Claim 27, therefore, would not have been obvious to a person of ordinary skill in the field of designing order-filling facilities and methods, based on the teachings of LoBiondo et al and Barnes et al.

Claims 2-5, 7, 9, 10, 13-18 and 21-26 add further steps to the non-obvious method of claim 1, and therefore would not have been obvious to a person of ordinary skill in the relevant field based on the teachings of LoBiondo et al and Barnes et al, for the same reasons discussed above in connection with claim 1. Similarly, claims 28-33 and 35 add further structure to the non-obvious arrangement of independent claim 27, and therefore would not have been obvious to a person of ordinary skill in the relevant field based on the teachings of LoBiondo et al and Barnes et al for the same reasons discussed above in connection with claim 27.

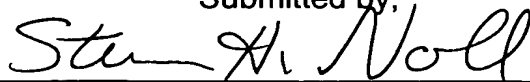
Claims 6, 34, 36, 39 and 40 were rejected under 35 U.S.C. §103(a) as being unpatentable over LoBiondo et al and Barnes et al, further in view of Coudray et al. The Examiner relied on the Coudray et al reference as teaching a device and a method for determining the quantity of a product that is present in a reservoir. Applicant does not disagree that the Coudray et al reference provides such a teachings, however, for the reasons discussed above, even if the combination of LoBiondo et al and Barnes et al were further modified in accordance with the

teachings of Coudray et al, the subject matter of claims 6, 34, 36, 39 and 40 still would not result.

Claims 11, 12, 19, 20, 37, 38 and 42 were rejected under 35 U.S.C. §103(a) as being unpatentable over LoBiondo et al and Barnes et al, further in view of a specification sheet for the Canon multi-pass C5500. The Examiner relied on the Cannon multi-pass C5500 specification sheet as teaching attaching an indicator, representing an ordering number to a supply item. Again, Applicant does not disagree that the Canon multi-pass C5500 specification sheet provides such a general teaching, but for the reasons discussed above regarding LoBiondo et al and Barnes et al, even if the combination of LoBiondo et al and Barnes et al were further modified in accordance with the teachings of the Canon multi-pass C5500 specification sheet, the subject matter of claims 11, 12, 19, 20, 37, 36 and 42 still would not result.

All claims of the application are therefore submitted to be in condition for allowance, and early reconsideration of the application is respectfully requested.

Submitted by,

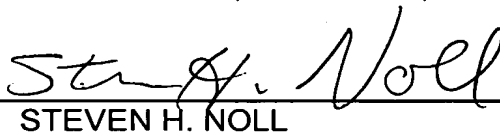


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